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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/778,022	02/17/2004	Hans-Ulrich Vogler	2001P80113WOUS	6174
28204	7590	07/09/2004		
SIEMENS SCHWEIZ I-44, INTELLECTUAL PROPERTY ALBISRIEDERSTRASSE 245 ZURICH, CH-8047 SWITZERLAND			EXAMINER	KEASEL, ERIC S
			ART UNIT	PAPER NUMBER
			3754	

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/778,022	VOGLER, HANS-ULRICH 
	Examiner	Art Unit
	Eric Keasel	3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 February 2004.
- 2a) This action is **FINAL**.                                   2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>Feb 17, 2004</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Priority***

1. This application is claiming the benefit under 35 U.S.C. 120 of a PCT application. Proof of copendency between the current application and the prior application is required. The evidence submitted to prove that the international application was copending with the U.S. national (35 U.S.C. 111(a)) application should include a certification from applicant that neither the international application nor the designation of the United States was withdrawn or considered to be withdrawn prior to the filing date of the U.S. national (35 U.S.C. 111(a)) application.

### ***Information Disclosure Statement***

2. The information disclosure statement filed Feb 17, 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. The Derwent Abstracts serve as the explanation of relevance for two of the references. However, DE2516190 does not include a concise explanation. It has been placed in the application file, but DE2516190 has not been considered.

*Drawings*

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “recesses within a housing of said throttle connection piece” (claim 7), “a plurality of shafts” (claim 8), and the connecting piece being connected to the throttle valve by encapsulation (claim 11) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

The case contains two each of claims 13-15. Misnumbered claims 13-18 (i.e. the second set of claims 13-15 and the present claims 16-18) have been renumbered 16-21.

5. Claim 9 is objected to because it appears that "an" at the end of line 2 should be deleted. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claim 16 (i.e. the second of the originally numbered claims 13) is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lines 1 and 2, "said an end of said connecting element" and "said connecting element" lack antecedent basis in the claims. It is unclear if this claim should be dependent on a different claim or if the first "said" should be deleted and the second "said" changed to "a".

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 6, 7, 9, 10, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by MacDonald (US Patent Number 4,057,217).

MacDonald discloses an arrangement for closing a through flow opening in a throttle valve connection piece comprising: a throttle valve shaft (19) positioned over and transverse to said through flow opening, said shaft pivotably mounted to said throttle valve connection piece (see Fig. 2); and a throttle valve (21) comprising a receiving opening running a length of and planar to said valve, said receiving opening comprising an interior opening (22) wherein said shaft is mounted such that said valve selectively closes said flow opening, and one or more recesses (35, 37) into said interior opening wherein said valve is connected to said shaft by at least one welding (49); wherein said valve comprises walls forming a hub, said hub comprising said receiving opening; wherein said throttle valve comprises a connecting element (41, 43) connected to said throttle valve and projecting into said recess, said connecting element comprising a material weldable to said throttle valve shaft; wherein said connecting element comprises two connecting elements (41, 43) arranged firmly connected to said throttle valve and projecting, in opposite directions to one another, tangential to said throttle valve shaft, and into said recesses (35, 37); wherein said shaft further comprises opposing ends projecting into recesses within a housing of said throttle valve connection piece (see Fig. 2); wherein said

connecting element extends, along said valve shaft, a substantial length of said recess; further comprising a plurality of connecting elements adjacently arranged within said recess and along said throttle valve shaft; wherein said throttle valve comprises a lightweight metal; and wherein said throttle valve shaft comprises steel.

10. Claims 1-4 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Obermaier (US Patent Number 3,675,681).

Obermaier discloses an arrangement for closing a through flow opening in a throttle valve connection piece comprising: a throttle valve shaft (35) positioned over and transverse to said through flow opening, said shaft pivotably mounted to said throttle valve connection piece; and a throttle valve (33) comprising a receiving opening running a length of and planar to said valve, said receiving opening comprising an interior opening wherein said shaft is mounted (see Fig. 2) such that said valve selectively closes said flow opening, and one or more recesses (near 34) into said interior opening wherein said valve is connected to said shaft by at least one welding (see column 2, line 19); wherein said valve comprises walls forming a hub, said hub comprising said receiving opening; wherein said throttle valve comprises a connecting element (34) connected to said throttle valve and projecting into said recess, said connecting element comprising a material weldable to said throttle valve shaft; and wherein said connecting element is welded to said throttle valve shaft at its projection within said recess.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 16-21 (as understood) are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MacDonald.

Regarding “prestress” and the various welding methods, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

13. Claims 11, 12, and 16-21 (as understood) are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Obermaier.

Regarding “injection molding” and “encapsulation” during its manufacture, “prestress” and the various welding methods, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

14. Claims 4, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacDonald.

MacDonald discloses the connecting element welded to the valve rather than the valve shaft. The examiner takes official notice that such a location of the weld is an old and well-known expedient in the art. MacDonald discloses a single shaft rather than two shafts. The examiner takes official notice that the use of multiple shafts is an old and well-known expedient in the art. Furthermore, it is noted that applicant has not shown this alternate embodiment.

15. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obermaier. Obermaier is silent as to the material selections set forth in claims 13-15. The examiner takes official notice that these material selections are old and well-known expedients in the art.

### *Conclusion*

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nassir, Lew, Wilson, and Yohner disclose similar throttle valves.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on (703) 308-2696. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Eric Keasel* 8 JUL 2004

Eric Keasel  
Examiner  
Art Unit 3754